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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,443	01/20/2004	Larry S. Eoff	2001-IP-005267U1P1	9208
71/407 7590 09/09/2009				
ROBERT A. KENT P.O. BOX 1431 DUNCAN, OK 73536				
EXAMINER				
FIGUEROA, JOHN J				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ROBERT.KENT1@HALLIBURTON.COM  
Tammy.Knight@Halliburton.com

# Office Action Summary

**Application No.**

10/760,443

**Applicant(s)**

EOFF ET AL.

**Examiner**

John J. Figueroa

**Art Unit**

1796

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 77-79, 81-87, 107-112, 187, 188, 190-196 and 198-220 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 77-79, 81-87, 107-112, 187, 188, 190-196 and 198-220 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. Receipt is acknowledged of a request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission (amendment), filed on July 22, 2009. This request has been deemed proper and this application has been hereby examined in view of said amendment.
2. Examiner notes that independent claims 77 and 187 have been amended in the amendment submitted with RCE to include new limitations and considerations thereby provoking the following restriction requirement.

### ***Election/Restrictions***

3. Claims 77-79, 82, 107-112, 187, 188, 198-203, 206-209 and 215-220 are respectively generic to the following disclosed patentably distinct species for the method of acidizing in a subterranean formation comprising providing a permeability-modifying treatment fluid modifier that includes a modifier that comprises a hydrophobically-modified water soluble polymer:
  - a. the hydrophobically-modified water soluble polymer having a molecular weight in the range of about 100,000 to 10,000,000 that is formed from the reaction of a hydrophobic compound and a hydrophilic polymer (as recited in claims 77, 83, 187, 192, 206 and 210);

- b. the hydrophobically-modified water soluble polymer having a molecular weight in the range of about 250,000 to 3,000,000 that is formed from a polymerization reaction that comprises a hydrophilic monomer and a hydrophobically-modified hydrophilic monomer (as recited in claims 77 and 187).
- 4. These species are independent or distinct because as disclosed they have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.
- 5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. That is, Applicant must elect **one** species for examination from a) or b) as listed above in paragraph #3.
- 6. In addition, **if Applicant elects species a)** [i.e., the hydrophobically-modified water soluble polymer having the specified molecular weight that is formed from the reaction of a hydrophobic compound and a hydrophilic polymer], **a further election of species is required for each of the following components:**
  - c. For the hydrophobic compound component:
    - i. Alkyl halide (claims 86, 195 and 213);
    - ii. Sulfonate (claims 86, 195 and 213);
    - iii. Sulfate (claims 86, 195 and 213);
    - iv. Organic Acid Derivative (claims 86, 87, 195, 196, 213 and 214).
  - d. For the hydrophilic polymer component:
    - i. Cellulose (claims 84, 193 and 211);

- ii. Polyamide (claims 84, 193 and 211);
  - iii. Polyetheramine (claims 84, 193 and 211);
  - iv. Polyhydroxyetheramine (claims 84, 193 and 211);
  - v. Polysulfone (claims 84, 193 and 211);
  - vi. Starch (claims 84, 85, 193, 194, 211 and 212).
7. However, **if Applicant instead elects species b)** [i.e., the hydrophobically-modified water soluble polymer having the specified molecular weight that is formed from a polymerization reaction that comprises a hydrophilic monomer and a hydrophobically-modified hydrophilic monomer], **a further election of species is required from each of the following:**
- e. For the hydrophilic monomer:
    - vii. One species such as those listed in paragraph [0031] on page 10 of the specification; and
  - f. For the hydrophobically-modified hydrophilic monomer:
    - viii. One species from the specification. [It is unclear to Examiner as to where there is written description support in the present specification for this particular component of species b).]
8. There is search burden for examination of these species [c) to f)] because they are drawn to various distinct classes of compounds requiring a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries). Moreover, the prior art applicable to one species may not

likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

9. Applicant is advised that the reply to this requirement to be complete must include (i) an election to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. That is, **Applicant must elect one species from a) or b)** as listed above in paragraph #3. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Furthermore, **if Applicant elects a)** from the species listed above in paragraph #3, **Applicant must further elect one species for each of c) and d)** from those listed in paragraph #6 above.

11. However, **if Applicant instead elects b)** from the species listed above in paragraph #3, **Applicant must further elect one species for each of e) and f)** from those listed in paragraph #7 above.

12. The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are

added after the election, applicant must indicate which of these claims are readable on the elected species.

Should Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

13. Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

14. A telephone call was made to Ms. Larissa Piccardo on September 2, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John J. Figueroa/  
Examiner, Art Unit 1796

JJF/JS